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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,498	01/16/2002	Kazutomi Taneda	1614.1208	1961
21171	7590	08/09/2007		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER BARTLEY, KENNETH	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/046,498

Applicant(s)

TANEDA ET AL.

Examiner

Kenneth L. Bartley

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

English translation of foreign application 2001-009132 is missing.

DETAILED ACTION

1. Receipt of Applicant's amendment and response filed on May 14, 2007 is acknowledged.

Response to Amendment

2. Claims 1-13 are currently amended. Claims 1-15 are pending and provided to be examined upon their merits.
3. Objection to the title is withdrawn.
4. Objection to the specification is withdrawn.

Response to Arguments

5. The Examiner thanks the Applicant for their response.
6. The Examiner did not receive an English translation of Applicant's foreign application, therefore, Pub. No. US 2001/0037316 to Shiloh is still valid prior art since it is before Applicant's U.S. filing date.
7. Despite not receiving an English translation, the Examiner reviewed Shiloh's provisional application (No. 60/191,625) with respect to Applicant's claims. While the responses presented below use Shiloh's published application, the Examiner believes similar support can be found in the provisional application.

Art Unit: 3693

8. Applicant's arguments filed May 14, 2007 have been fully considered but they are not persuasive. Reasons are presented below.

Regarding claims 1, 2, and 9:

9. On the top of page 9, Applicant argues that Shiloh's application fails to teach or suggest communication or transaction in the virtual world using virtual personal information.

The Examiner respectfully disagrees. Shiloh teaches:

"The present invention seeks to enhance user activity on a large communication network, e.g., the Internet, by creating new users and enhancing the activity of existing users, through the creation of user-controlled, preferably customizable, virtual entities equipped with tools designed for effective interaction on the Internet. For practical purposes of interacting on a global communication network, such as the Internet, the virtual entities created in accordance with the invention may have the same functionality and powers as real entities interacting on the Internet. By creating virtual entities in accordance with the invention, the real users behind the virtual entities remain anonymous while interacting freely on the Internet and engaging in activities such as surfing, e-mailing, shopping, chatting or any other activity offered by Internet sites." ¶ [0018]

10. Applicant argues on page 9, 1st paragraph, that Shiloh's application or provisional does not teach a virtual address in a virtual city within a virtual world.

The Examiner respectfully disagrees. Shiloh teaches:

"As described in detail below, a virtual entity in accordance with the invention may be provided with an e-mail account, virtual credit card information, e.g., a virtual credit card number and expiration date, an imaginary name, an imaginary address, a virtual social security number, and any other data that may be required for the Internet activity of the virtual entity." ¶ [0020] An address usually includes a city, therefore an imaginary address could include a virtual city.

Also... "In this manner, virtual personalities may share or exchange information in the virtual world, and may get to "know" one another." ¶ [0072]. Clearly Shiloh is creating a virtual world, separate from the real one.

Art Unit: 3693

11. Regarding claim 10, Applicant argues on page 9, 3rd paragraph, that delivery and/or settlement of items depending on commercial transactions is not provided in the provisional application, and that they were added in Shiloh's complete application.

The Examiner respectfully disagrees and believes there is support for settlement of transactions in the application.

Regarding claim 12:

12. Applicant argues on page 9, 4th paragraph that claim 12 is not taught by Shiloh's applications because Shiloh merely teaches transactions in the real world using virtual personal information.

The Examiner notes that to reach Applicant's "virtual shops", they have to use a "network" which the Examiner believes to be real. This is the same as in Shiloh's disclosures where a network is used to reach virtual shops.

13. The Applicant continues to argue that there is no virtual address or virtual personal information in Shiloh's applications.

The Examiner respectfully disagrees as pointed out above and believes there is support for virtual address as well as fictional identification information.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub.

No. US 2001/0037316 to Shiloh.

16. Regarding applicant claims 1-15, Shiloh discloses:

- a. A communication network that includes the Internet, intranets, and local networks (bottom of para. 18);
- b. A real entity represented by a virtual entity "...with an imaginary name, an imaginary address, a virtual social security number, and any other data that may be required for the Internet activity of the virtual entity." (middle of para. 20);
- c. A computer system that manages both the real and virtual person (para. 21 and para. 25), and provides a link between the virtual user and the real user (bottom of para. 27);
- d. Ability to conduct commercial transactions on the Internet using a "virtual personality" (para. 22);
- e. Shipping items to a real address based on a virtual transaction (middle of para. 31) by a virtual entity;
- f. The ability of a virtual person to authenticate (confirm) a transaction on the Internet using a fictional user name and information (middle of para. 26);
- g. The user logs into a site by "...presenting the virtual user access ID and virtual user access password..." to gain access to their virtual identity (para. 85);
- h. A virtual entity may obtain a virtual debit and credit card number (para. 20);
- i. Virtual users are able to make purchases of goods, presumably from virtual stores (middle of para. 31);

- j. Users can have personalized virtual home pages that serve as "homes" for the virtual entities (middle of para. 35) and a "...virtual entity may enter a chat room and interact with other real and/or virtual entities." (para. 20);
- k. The system "...may be an organization operating a server site or series of server sites providing access to the Internet and/or other services..." (para. 21). Therefore, while "virtual station" and "virtual city space" are not discussed, Shiloh has the capability of offering it in that they provide virtual address information and provide management of the system. Also, entities can change personalities, which would include their virtual address (para. 23).

Conclusion


17. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth L. Bartley whose telephone number is (571) 272-5230. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jagdish Patel can be reached on (571) 272-6748. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 8-1-07
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